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OFFICE OF PETITIONS

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In re Patent No. 7,541,335 : DECISION ON REQUEST FOR
Roman J. Giger : RECONSIDERATION OF
Issue Date: June 2, 2009 : PATENT TERM ADJUSTMENT
Application No. 10/551,833 : AND NOTICE OF INTENT TO ISSUE
Filed: July 20, 2006 : CERTIFICATE OF CORRECTION
Docket No. 20724-011US1 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d), filed July 29, 2009. Patentee requests that the determination of patent term adjustment for the above-identified patent be corrected from zero (0) days to one hundred ninety-six (196) days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED** to the extent indicated herein.

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **196 days**.

On June 2, 2009, the above-identified application matured into U.S. Patent No. 7,541,335. The patent issued with a revised patent term adjustment of 0 days. The present request for reconsideration of patent term adjustment was timely filed on July 29, 2009, within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees aver that the correct number of days of patent term adjustment is 196 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Patentees maintain that the total period of Office delay is the sum of the period of Three Year Delay¹ (241 days) and the period of examination delay (0 days) to the extent that these periods of delay are not overlapping. Patentees contend no periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap. Therefore, patentees assert that they are entitled to the sum of 0 days of examination delay - 45 days of applicant delay + 241 days of Three Year Delay, for a total patent term adjustment of 196 days.

The Office has reviewed patentees' argument and finds it persuasive.

37 CFR 1.703(b) provides, in pertinent part:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

an international application and ending on the date a patent was issued[.]

Pursuant to 37 CFR 1.703(b)(1), a period of adjustment under § 1.702(b) of 241 days should have been entered, counting the number of days in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), October 5, 2008, and ending on the date the patent issued, June 2, 2009.

Accordingly, a period of adjustment of 241 days pursuant to 37 CFR 1.702(b) will be entered.

In view thereof, the patent term adjustment indicated on the patent should be 196 days (241 days of Office delay - 45 days of applicant delay).

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 196 days.

Telephone inquiries regarding this matter should be directed to Kenya A. McLaughlin, Petition Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,541,335 B2

DATED : Jun. 2, 2009

INVENTOR(S) : Giger

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase "by 0 days" and insert – by 196 days--